

Applicant : Hermann Lueckhoff
Serial No. : 10/814,832
Filed : March 31, 2004
Page : 9 of 13

Attorney's Docket No.: 13906-0164001/2004P00290 US

REMARKS

The final Office Action of April 1, 2009, rejected all pending claims. In this Amendment in Reply (being filed with a Request for Continued Examination), Applicant amends claims 1, 2, 6-8, 10-12, 14-16, 20, and 21; and cancels claims 5 and 19. Claims 23-24 are still withdrawn. As such, claims 1-4, 6-18, and 19-24 remain pending. Applicants respectfully request the Examiner's consideration of the pending claims in view of the amendments and remarks set forth in this Amendment in Reply

Interview Summary

Through the undersigned representative, Applicant conducted an interview with the Examiner on April 30, 2009. The interview generally pertained to the claim rejections set forth in the Office Action, the references cited in the Office Action, and claim amendments proposed by Applicant. Agreement was reached that Applicant's proposed claim amendments (incorporated into the claims above) overcome the rejections under 35 U.S.C. §§ 101 and 112, first paragraph. Agreement was also essentially reached that Applicant's proposed amendment of independent claims 1, 11, and 15 overcome U.S. Publication No. 2004/0064512 to Arora et al. ("the Arora reference") and the corresponding rejections under 35 U.S.C. § 102(e).

Applicant thanks the Examiner for taking the time to conduct an interview regarding this application.

Claim Amendments: Claims 1, 2, 6-8, 10-12, 14-16, 20, and 21

Applicants amend independent claims 1, 11, and 15, and dependent claims 2, 6-8, 10, 12, 14, 16, 20, and 21. Support for these amendments can be found throughout the specification, for example, at FIGS. 1-2 and pages 4-6 and 13. As such, these amendments add no new matter.

Claim Rejections – 35 U.S.C. § 101

The Office Action rejects claims 11-14 and 15-22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As indicated above, Applicants amend independent

claims 11 and 15 to recite a “computer readable storage medium” (emphasis added). As suggested in the Office Action at page 3 and as agreed during the interview of April 30, 2009, such an amendment properly defines statutory subject matter and overcomes the rejection under 35 U.S.C. § 101. As such, Applicant respectfully requests removal of the rejection under 35 U.S.C. § 101 of independent claims 11 and 15, as well as the rejection of claims 12-14 and 16-22, which depend either directly or indirectly from claim 11 or claim 15.

Claim Rejections – 35 U.S.C. § 112

The Office Action rejects claims 1-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. As indicated above, Applicants amend independent claims 1, 11, and 15 to no longer recite “fact attributes within the incoming electronic message and comparing the fact attributes with,” which the Office Action alleges to be subject matter not described in the original specification and claims. (*See* Office Action at p. 3). As agreed during the interview of April 30, 2009, such amendments of the independent claims overcome the rejections under 35 U.S.C. §112. As such, Applicant respectfully requests removal of the rejection under 35 U.S.C. § 101 of Applicant’s independent claims, as well as the rejections of claims 2-10, 12-14 and 16-22, which depend either directly or indirectly from one of the independent claims.

Claim Rejections – 35 U.S.C. §§ 102 and 103

The Office Action rejects claims 1-3, 5-9, 11-17, and 19-22 under 35 U.S.C. § 102(e) as being anticipated by the Arora reference. The Office Action rejects claims 4, 10, and 18 under 103(a) as being unpatentable over the Arora reference in view of U.S. Patent No. 7,130,885 to Chandra et al. (“the Chandra reference”). These rejections are rendered moot by the above amendments, but Applicant is not conceding that the rejection has merit.

Applicant’s claims are patentable over the cited references because the cited references, whether taken alone or in combination, do not teach or suggest “determining a first pre-selected class of a plurality of classes of stored fact information” for “stored fact information [that] is external to the incoming electronic message,” as recited in Applicant’s independent claims (as amended).

Applicant's claimed subject matter relates to "retrieving information related to a received electronic message." (Abstract). More specifically, Applicant's claimed subject matter relates to "retriev[ing] information from other sources that relate[] to the message, because such information can be important in deciding what to do with [an incoming electronic message]." (Spec. at p. 4, first paragraph). For example, the retrieved related information can be used to "route [an incoming electronic message] to an agent of the organization to handle the message." (*Id.*).

The claims bear out aspects of the example information retrieval features above. For example, Applicants' independent claims (as amended) recite "upon receipt of an incoming electronic message in a computer system, selecting a first meta information from a plurality of meta information portions based on information retrieved from the incoming electronic message, wherein each meta information includes a rule and a fact attribute identified by the rule, wherein the fact attribute specifies a pre-selected class of stored fact information that is associated with the incoming electronic message, wherein **stored fact information is external to the incoming electronic message.**" (emphasis added).

In contrast, the Arora reference is directed to "a distributed instant messaging system that uses a distributed index . . . to implement an instant messaging system in a group of participating peers." (Arora at Abstract). The Aurora reference teaches that an incoming electronic message is distributed based on the message's content, not on information external to message. For instance, the Aurora reference discloses that "keywords and subjects of interest may be registered in a distributed index, and **when a content including the registered metadata appears** on the network, all nodes that have **registered for that content** may be notified." (*Id.* at [0080]) (emphasis added). Nowhere does the Arora reference teach or suggest "determining a first pre-selected class of a plurality of classes of stored fact information" for "stored fact information [that] is external to the incoming electronic message," as recited in Applicant's independent claims.

The Chandra reference does not cure the deficiencies of the Arora reference. The Chandra reference is distinct from Applicant's claimed subject matter in that it is directed to "a method for associating related electronic messages in computer storage." (Chandra at Abstract). The Chandra reference appears to be relied upon by the Office Action only with regard to XML

and XSL. (*See* Office Action at pp. 9-10). Nowhere does the Chandra reference teach or suggest “stored fact information is external to the incoming electronic message,” let alone “determining a first pre-selected class of a plurality of classes of stored fact information,” as recited in Applicant’s independent claims (as amended).

For at least the foregoing reasons, the cited references do not anticipate or render obvious Applicant’s independent claims 1, 11, and 15. As such, Applicant respectfully request the Examiner remove the rejections under 35 U.S.C. § 102 of independent claims 1, 11, and 15, as well as claims 2-3, 5-9, 12-14, 16-17, and 19-22, which depend either directly or indirectly from one of the independent claims. For at least the same reasons, Applicant respectfully request the Examiner remove the rejections under 35 U.S.C. § 103 of dependent claims 4, 10, and 18, which dependent either directly or indirectly from one of the independent claims.

Conclusion

Applicant submits that claims 1-4, 6-18, and 19-22 are in condition for allowance, and request that the Examiner issue a notice of allowance.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant : Hermann Lueckhoff
Serial No. : 10/814,832
Filed : March 31, 2004
Page : 13 of 13

Attorney's Docket No.: 13906-0164001/2004P00290 US

Please apply \$810 for the Request for Continued Examination Fee and any other charges or credits to deposit account 06 1050.

Date: 5/19/04

Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (612) 335-5070
Facsimile: (877) 769-7945

Respectfully submitted,



J. Richard Soderberg
Reg. No. 43,352